



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,060	08/01/2003	Tienyu Chiu	LUC-419/Chiu 4	3584
32205 7590 01/11/2008 PATTI, HEWITT & AREZINA LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			EXAMINER O CONNOR, BRIAN T	
			ART UNIT 2619	PAPER NUMBER
			MAIL DATE 01/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,060

Applicant(s)

CHIU, TIENYU

Examiner

Brian T. O'Connor

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to Applicant's amendment filed on 10/22/2007.
2. Claims 1, 2, 6, and 7 have been amended. Claims 1-10 are currently pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, on lines 14-15 the claim recites "an IP telephone set". The functional relationship of this "an IP telephone set" is not defined with regard to the "first IP telephone" and the "PSTN switch" recited earlier in the claim.

With respect to claim 6, on lines 13-14 the claim recites "an IP telephone set". The functional relationship of this "an IP telephone set" is not defined with regard to the "first IP telephone" and the "PSTN switch" recited earlier in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schessel (US 6,304,566) in view of Ress et al. (US 6,885,658; hereafter Ress).

With respect to claims 1 and 6, Schessel disclose a method for a central office (CO) device (16a of Figure 1A; viewed as a PSTN switch) to provide Internet subscribers with calling features (Abstract). The CO contains an IP interface (27 of Figure 1A; column 4, lines 44-53; viewed an equivalent to an IP peripheral unit) that accepts incoming IP packets with requests for call features (column 5, lines 33-53). The IP interface communicates with a trunk unit (29 of Figure 1A; column 4, lines 54-65; viewed as a packet line trunk unit) to check the subscribers eligibility for requested features. Next, a call processing processor (22 of Figure 1A; viewed as an applications processor) will communicate with a features database (32 of Figure 1A; column 4, lines 54-64; referred to as 35 of Figure 1A; viewed as a directory database) to verify the eligibility of the subscriber's request for a feature. If the feature indicates Internet usage then the CO will transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4). The features taught by Schessel include call ID and three-way calling (column 4, line 65 -- column 5, line 2). Schessel also shows an IP telephone (404 of Figure 3A) connected to the PSTN switch only by an IP connection (14' of Figure 3A).

However, Schessel fails to disclose a request with a telephone directory number of a called party.

Ress discloses a method where a number of gateways and agents (1800, 1802, 1804, 1806, 1808 of Figure 18; 1402, 1602 of Figure 19) that translate TCP/IP request messages into PSTN signal messages (Abstract; column 4, lines 34-54; column 18, lines 7-15). The setup message transmitted includes a telephone number of a called party (column 19, lines 27-35; line 2, line 3 of Figure 19).

Ress teaches the advantage of increased compatibility and greater flexibility of the gateways and agents (column 5, lines 15-35). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the gateways and agents with their setup messages as taught by Ress with the method of Schessel.

With respect to claims 2 and 7, Schessel further discloses if the feature indicates Internet usage then the CO will transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4). The features taught by Schessel include caller ID and three-way calling (column 4, line 65 -- column 5, line 2). Caller ID information is sent back to the IP telephone set.

With respect to claims 3 and 8, Schessel further discloses if the feature indicates Internet usage then the CO will transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4). The features taught by Schessel include caller ID and three-way calling (column 4, line 65 -- column 5, line 2). Caller ID information is sent to the called IP telephone set.

With respect to claims 4 and 9, Schessel further discloses if the feature indicates Internet usage then the CO will transmit to a subscriber's personal computer and telephone (400, 402, 404 of Figure 3A; 211, 212, 216 of Figure 4), otherwise the CO will transmit to a POTS telephone on the PSTN network (214 of Figure 4).

With respect to claims 5 and 10, Schessel further discloses the features include call ID and three-way calling (column 4, line 65 -- column 5, line 2).

Response to Arguments

7. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment to claims 1 and 6.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. O'Connor whose telephone number is 571-270-1081. The examiner can normally be reached on 9:00AM-6:30PM, M-F, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

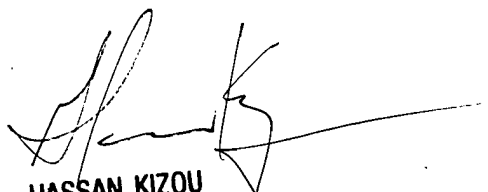
Application/Control Number:
10/633,060
Art Unit: 2619

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BTO

Brian T. O'Connor
December 27, 2007
Patent Examiner



HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600